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Paper No. 10

Foley & Lardner
402 W. Broadway, 23rd Floor
San Diego, CA 92101

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AUG 13 2001

In re Application of :
Dershem et al :
Application No. 09/580,026 :
Filed: May 26, 2000 :
Attorney Docket No. QUANT1190-2 :

OFFICE OF PETITIONS
ON PETITION

This is in response to the petition filed June 18, 2001, requesting reconsideration of a decision mailed which refused to accord 37 CFR 1.47(a) status to the above-identified application.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor in compliance with 37 CFR 1.63. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the nonsigning inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the nonsigning inventor. Applicant lacks item (1) set forth above.

As to item (1), petitioner still has not demonstrated that diligent efforts were made to locate joint inventor Dennis Patterson such that the declaration under 37 CFR 1.47(a) can be accepted. It appears that a second unsuccessful mailing was made to the same address as before but that the package was returned as

undeliverable with an indication that the forwarding order had expired. Therefore, it cannot be concluded that a diligent effort was made to locate inventor Patterson. In view of the return of the package and since petitioner is aware that inventor Patterson no longer resides at the address to which the package was delivered, petitioner should demonstrate other efforts made to locate inventor Patterson. In this regard, does petitioner have access to inventor Patterson's employee records and, if so, what does inspection of the records reveal as to a current address, forwarding address, or an address of the nearest living relative? What does inspection of the phone directories for those address locations reveal? Has petitioner attempted to locate inventor Patterson on the Internet¹ or the White Pages for the greater California area? If so, a copy of those search results should be presented as documentary evidence. If inventor Patterson is located, then a complete copy of the application papers (specification, claims, drawings, oath, etc.) should be mailed to Mr. Patterson's address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. If the papers are returned and all other attempts to locate or reach the inventor, e.g., through e-mail, the telephone, etc., continue to fail, then applicant will have established that the inventor cannot be reached or has refused to join in the application. The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein.

If the inventor is located and the inventor orally refuses to join in the application, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. If, on the other hand, petitioner receives an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to consider submitting the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.

Further correspondence with respect to this matter should be addressed as follows:

¹ A search on the Internet (Yahoo and Lexis) indicated a number of Dennis Patterson's listed.

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions, Frances Hicks

By hand: Crystal Plaza 4, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-8680.

A handwritten signature in cursive script that reads "Frances Hicks".

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy